REMARKS

Claims 1, 2, 4, 6-32, 36, 37, 39 and 63, 65-81 are pending.

In the present response, claims 1-2, 4 and 21 are amended, and claims 3 and 64 are canceled. No new matter has been added by way of the amendments to claims 1, 2, 4, and 21.

Claim 30 stands rejected under 35 U.S.C. § 112, first paragraph as not enabled.

Claims 1-3, 5-32, 36, 37, 39 and 63-81 stand rejected under 35 U.S.C. § 103(a).

Claims 63-81 are objected to for being substantial duplicates of the claims from which they depend.

Rejections under 35 U.S.C. § 112, first paragraph

Claim 30 is rejected under 35 U.S.C. §112, first paragraph as allegedly not being enabled.

Applicants traverse.

The Examiner asserts that claim 30 lacks enablement for the following terms: biologic response modifiers, glucocorticoids, DPP-IV inhibitors, GK activators, insulin mimetics, insulin secretagogues, insulin sensitizers, GLP-1 mimetics and fibrates.

In response to the Applicants arguments filed January 16, 2008, the Examiner relies on *In re Gardner* 166 USPQ 138 (C.C.P.A. 1970) for the proposition that a specification must teach how to make and use the invention rather than teaching one to figure out how to make and use the invention. In *Gardner*, the claimed invention was to "antidepressant activity" and the issue before the court related to enablement of the claimed "activity"; and, in particular, to activity in terms of use. That is not the case here. Claim 30 recites "The pharmaceutical composition of claim 25, further comprising one or more therapeutic agents ..." The claim is to a composition only, and there are no use claims for the added therapeutic agent. Thus one skilled in the art recognizes the pharmaceutical composition of claim 25 and needs little or no experimentation to merely combine the therapeutic agent of claim 30.

Claim 30 is a composition claim without limiting terms to a use.

> *"....when a compound or composition claim is not limited by a recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for nonenablement based on how to use."*
>
> MPEP 2164.01(c)

Therefore, since claim 30 does not contain a recited use, any enabled use that would reasonably correlate with the entire scope of the claims is sufficient to preclude a rejection for non-enablement. Claim 30 does in fact have an enabled use.

Claim 30 recites a list of therapeutic agents which, like the compounds of claim 1, are potentially useful in the treatment of diseases as listed in the Specification on page 2, lines 21-26. As discussed in Applicant's response dated January 16, 2008, pages 29-31, the objected to agents were known at the time of the present invention. Moreover, the various uses of these agents were also known at the time of filing the present invention. The compounds in the composition of claim 25 have the use recited in the written description and the agents that are recited in claim 30 have uses that were known on the filing date of the present invention. As alluded to previously, because claim 30 is not limited by a recited use, any enabled use is sufficient to render claim 30 enabled. Applicants submit that in the composition of claim 30 because both the compounds use is known (as disclosed in the written description) and the use of the various agents were known on the date of the filing the instant application, one can only conclude that claim 30 is enabled for its full scope.

The fact that particular specific agents may not be disclosed is of no relevance. In this regard, Applicants remind the Examiner that "[a] patent need not teach, and preferably omits, what is well known in the art." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Applicants submit that various species of biologic response modifiers, glucocorticoids, DPP-IV inhibitors, GK activators, insulin mimetics, insulin secretagogues, insulin sensitizers, GLP-1 mimetics and fibrates were well known in the

art on the filing date of the present invention. Therefore, and in accordance with the holdings in the above identified cases, the present invention need not teach again those compounds that were well known in the art on the date of filing the present invention.

Additionally, to determine whether a disclosure meets the enablement requirement so that one of skill in the art could make and use the claimed invention without undue experimentation, one needs to weigh the *Wands* factors. See *In re Wands*, 8 USPQ 2d 1400 (Fed. Cir. 1988). As set forth below, and contrary to the Examiner's position, the *Wands* factors actually support Applicants' position that the present claim is fully enabled.

The nature of the invention.

The Examiner asserts that claim 30 recites a composition with a list of additional therapeutic agents not adequately described in the instant specification. The Examiner also asserts that the specification does not teach how to make and use the invention. The Examiner is correct that claim 30 recites a composition claim. However, Applicants submit that the Examiner is not correct to assert that the therapeutic agents are not adequately described in the specification. Because a plurality of compounds that fit within the scope of the claimed agents were known and their use were well known on the filing date of the present invention, one skilled in the art would know how to make and use the claimed composition. Applicants remind the Examiner that the nature of the invention of claim 30 is a composition claim that recites no intended use. Thus, as noted above, because the agents had a known use at the time of filing the invention, an enabled use was known that reasonably correlates with the scope of the claim.

The state of the prior art and the predictability or lack thereof in the art.

The Examiner asserts that there are no indications of compounds embraced by the various agents, that the state of the art in the pharmaceutical arts is highly unpredictable, and that one of ordinary skill in the art would not accept a therapeutic regimen on its face.

Typical compounds of the objected to agents were well known at the time of filing and described in the literature so that one skilled in the art would not need to be reminded with a long list of known compounds.

Further, contrary to the Examiner's assertions, claim 30 neither recites a method of therapy nor recites a method of treatment. Rather, claim 30 is directed to a composition comprising a compound of Formula I further comprising a therapeutic agent. In this regard, to add a therapeutic agent that was known in the art to a compound that is described in written description can in no way be asserted to be unpredictable.

The amount of direction or guidance present and the presence or absence of working examples.

Applicants note that claim 30 is directed to a composition and not directed to a method of use or a method of therapy. Applicants submit that to add a therapeutic agent that was known in the art to a compound that is described in written description does not require any guidance nor does it require any working examples. One of skill in the art could certainly practice the claimed invention without undue experimentation.

The breadth of the claims.

As noted herein, the present claim is directed to a composition comprising a compound and further comprising a therapeutic agent. The specification and the compounds that were known at the time of filing the application provide sufficient enablement to support the agents currently allowed as well as those objected to.

The quantity of experimentation needed.

The present specification supports the presently claimed pharmaceutical composition. The therapeutic agents recited in claim 30 were well known at the time of filing and their use is well documented in the literature. Thus, one skilled in the art could practice the claimed invention (*i.e.*, make and use the claimed composition) without undue experimentation.

The level of the skill in the art.

The Examiner acknowledges that the level of skill in the art is high, however, the Examiner refers to the alleged unpredictable nature of the composition of claim 30 as preventing one skilled in the art from using the present claim without undue experimentation. Applicants respectfully traverse the Examiner's position.

In contrast to the Examiner's assertion, Applicants submit that the use of the various recited agents were known at the time of filing the application. In other words, the objected to agents are not unpredictable since there exists adequate knowledge to predictably allow one skilled in the art to practice the invention recited in the claim without undue experimentation.

In view of the *Wands* factors discussed herein above, Applicants submit that the weight of evidence clearly favors compliance of claim 30 with the enablement requirement of 35 U.S.C. §112 first paragraph. Applicants respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-3, 5-32, 36, 37, 39 and 63-81 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thurieau et al. (WO 2002/10140) and Thurieau et al. (WO 99/64401) each taken alone or in combination. Claim 64 is canceled and so the rejection is moot with respect to claim 64.

The Examiner asserts that the prior art teaches imidazole compounds that are structurally similar to the presently claimed compounds; the present compounds being embraced by the genus of both Thurieau references, and the latter Thurieau reference suggesting the present claims to one of ordinary skill in the art. Applicants disagree, but to expedite the prosecution of the present application, Applicants have amended claim 1 without prejudice to refiling of the omitted subject matter.

The variables W, R_4, L_2, D and G in claim 1 have been amended to substantially conform to their respective definitions in claim 4.

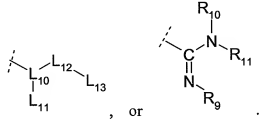
NR_4 (defined as W) has been amended to remove the R_4 groups -hydrogen; -L_2-D-alkyl;– L_2-D-aryl;– L_2-D-heteroaryl;– L_2-D-cycloalkyl;– L_2-D-heterocyclyl;– L_2-D-

arylene-alkyl;– L_2-D-alkylene-cycloalkyl;– L_2-D-alkylene-heterocyclyl;– L_2-D-alkylene-aryl;– L_2-D-alkylene-heteroaryl;– L_2-D-alkylene-arylene-alkyl; – L_2-D-alkylene-heteroarylene-alkyl;–L_2-D-alkyl-G;– L_2-D-aryl-G;– L_2-D-heteroaryl-G;– L_2-D-cycloalkyl-G;– L_2-D-heterocyclyl-G;– L_2-D-arylene-alkyl-G;– L_2-D-alkylene-cycloalkyl-G;– L_2-D-alkylene-heterocyclyl-G;– L_2-D-alkylene-aryl-G;– L_2-D-alkylene-heteroaryl-G;– L_2-D-alkylene-arylene-alkyl-G; and – L_2-D-alkylene-heteroarylene-alkyl-G.

The L_2 group has been amended to remove a direct bond.

The D group has been amended to remove the groups –CH_2-, -O-, -N(R_5)-, -C(O)-, -CON(R_5)-, -N(R_6)C(O)-, -N(R_6)CON(R_5)-, -N(R_5)C(O)O-, -OC(O)N(R_5)-, -N(R_5)SO_2-, -SO_2N(R_5)-, -C(O)-O-, -O-C(O)-, -S-, -S(O)-, -S(O_2)-, -N(R_5)SO_2N(R_6)-, -N=N- and -N(R_5)-N(R_6).

The G group has been amended to remove the groups –CN, -SO_3H, -P(O)$(OH)_2$, -P(O)(O-alkyl)(OH), –CO_2H, -CO_2-alkyl, an acid isostere, -NR_7R_8,



, or .

The groups listed as A, X, R_1, R_2, R_3, Ar_1, Ar_2, L_1 and T are from the groups originally listed in original claim 1.

The definition of L_2 in claim 1 differs from claim 4 by including alkylene which was recited in the original definition of L_2 in original claim 1. Applicants assert that with the added definition of L_2, claim 1 in independent form is neither obvious over nor anticipated by the prior art.

Claim 4 has been amended to recite the correct spelling of alkenylene and alkynylene consistent with the definition of L_2 in original claim 1.

Terms R_4 and D in claim 2 have been amended to be consistent with the definitions of R_4 and D in amended claim 1, so that claim 2 is properly dependent from claim 1.

Dependent claim 4 has been rewritten to fit within the scope of the claim from which it depends (*i.e.*, claim 1).

Applicants believe that with the incorporation of the subject matter from claim 4 into claim 1, neither Thurieau reference can render obvious the presently claimed invention as there is no overlap between the instant claims and the genera disclosed in the Thurieau references. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-32, 36, 37, 39 and 63-81.

Claim Objections

Claims 63-81 are objected to as allegedly being substantial duplicates of the claims from which they depend. The objection to claim 64 is moot since claim 64 is canceled.

Applicants traverse the objection to claims 63 and 65-81 as being substantial duplicates of the claims from which they depend.

The subject matter of the claims from which claims 63 and 65-81 depend is, in each claim, a particular sub-genus of the genus recited in claim 1. Thus, in claims 63 and 65-81 each claim recites a pharmaceutical composition comprising a compound represented by a different subgroup of Formula I.

Relative to the claims from which they depend, claims 63 and 65-81 each recite the limitation "a pharmaceutical composition". Thus, the pharmaceutical compositions comprising the compounds recited in claims 63 and 65-81 are different than the compounds and the claims from which they depend. Therefore, the claims are not duplicates. Applicants respectfully request withdrawal of the objections to claims 63 and 65-81.

Conclusion

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants herein petition for a three-month extension of time. Applicants believe that no additional fee beyond the extension fee is necessary; however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

Date: September 18, 2008

Ben Schroeder

T. Benjamin Schroeder (Reg. No. 50,990)
KILPATRICK STOCKTON LLP
1001 West Fourth Street
Winston-Salem, North Carolina 27101-2400
Phone: (336) 607-7486
Facsimile: (336) 607-7500